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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,355	02/25/2004	Robert Linley Muir	18226US01	4864
23446 7590 12/06/2011 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661				
EXAMINER HENRY, THOMAS HAYNES				
ART UNIT		PAPER NUMBER		
3717				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mhmpto@mcandrews-ip.com

Office Action Summary**Application No.**

10/787,355

Applicant(s)

MUIR, ROBERT LINLEY

Examiner

THOMAS H. HENRY

Art Unit

3717

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/23/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 35-61 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 35-61 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-501a)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 47-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. In re claim 47, applicant claims "a gaming console comprising a seed buffer", and later "a seed buffer coupled to the gaming console". It is believed these are the same seed buffers, in which case one of these statements needs to be removed.

4. In re claim 58, applicant claims "the secure storage and processing device read/write interface of said gaming console communicates with smartcard via a secure communications system provided by a further smartcard device". Applicant need to claim "a smartcard", or "the smartcard". It is believed by examiner that applicant meant to claim "the smartcard" and the claim is meant to be dependent upon claim 50.

5. In re claim 60, applicant claims "the smart card". This lacks antecedent basis. It is believed the claim is meant to be dependent upon claim 50.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3717

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 35, 36, 38-44, 46-49, 51-57, 59, and 61 are rejected under 35

U.S.C. 102(e) as being anticipated by Schneier et al (US 5871398).

3. In re claims 35 and 47, Schneier discloses

- A game server (figure 12, #11, 12)
- A gaming console comprising a seed buffer, the gaming console arranged to communicate with the game server over a communication network (Figure 12 #HTV 20)
- A seed buffer coupled to the gaming console (figure 5 #168)
- A secure storage and processing device removably coupled to the gaming console via a secure storage and processing device read/write interface, the secure storage and processing device arranged to carry out the following steps in order to facilitate game play on the gaming console (fig 1 #28):
 - Process a random seed stored by the seed buffer to generate a set of random numbers, in response to a user initiating play of a game on the gaming console (column 6 lines 42-47)
 - Determine an outcome for the game based, at least in part, on the set of random numbers and communicating the determined outcome to the gaming console, via the secure storage and processing device read/write interface (column 24 lines 29-31)

Art Unit: 3717

- Automatically request, via the gaming console, a plurality of additional seeds from the gaming server for subsequent storing in the seed buffer, in response to the gaming console determining that a number of unprocessed seeds stored in the seed buffer is less than a predetermined number (figure 7. Additional seeds are automatically requested from the gaming server when it is determined that a number of unprocessed seeds is less than the amount which has been purchased, thus the amount of tickets purchased is the predefined number.)
4. In re claims 36 and 48, Schneier discloses the number of additional seeds communicated to the gaming console is dependent on a delay associated with requesting seeds over the communication network (communication is always dependent upon a delay, this is inherent)
5. In re claims 38 and 51, Schneier discloses the set of random numbers to be used to determine a gamble outcome are produced by the secure storage and processing device, the console then choosing a game outcome which will achieve that gamble outcome (column 15 lines 45-50)
6. In re claims 39-41, 52-54, and 59 Schneier discloses the secure storage and processing device generates game verification data which is stored until the secure storage and processing device is in communication with the gaming server at which time the secure storage and processing device communicates the game verification data to the gaming server (col. 18, lines 34-67). The secure storage and processing device communicates the game verification data to the

Art Unit: 3717

gaming server via the console, as the HTV memory 100 is located within the console.

7. In re claims 42-44, 56, and 57, Schneier discloses a bet on an outcome, and inhibiting further play represented by a number of unprocessed random seeds when the bet exceeds a number of wins by the maximum loss value or greater (the player is inhibited from playing once the player runs out of seeds)

8. In re claims 46 and 61, Schneier discloses the console sends a signal to the secure storage and processing device describing a state of a game being played for communication to the gaming server (figure 7)

9. In re claim 49, Schneier discloses the secure storage and processing device using an algorithm known to the server whereby the server can predict the outcome derived (column 15 lines 20-28)

10. In re claim 55, Schneier discloses a wager input means and the game play includes a bet being made on outcome of said game (figure 7)

Claim Rejections - 35 USC § 103

11. Claims 37, 45, 50, 58, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of McCarthy (US 5276312).

12. In re claims 37 and 50, Schneier does not specifically disclose the secure storage and processing device is a smartcard or smartcard chip. Instead, Schneier discloses the secure storage and processing device is contained in the gaming console in the form of the memory 100, which in turn contains one-way function 144 (Fig. 6). Schneier discloses the use of a smart card, wherein an authenticable game authorization message AGAM may be written to a memory in

Art Unit: 3717

the smart card 28, the smart card may be inserted into the gaming console to be read by said console (col. 14, lines 12-17). Schneier further discloses the AGAM may comprise a random number seed for communication from the central server to the gaming console via the smart card (col. 15, lines 20-22). However, in this embodiment, the smart card disclosed by Schneier does not process the random number seed in order to generate game outcomes to be displayed by the game console.

13. In an analogous gaming device, McCarthy discloses the use of smart cards in conjunction with a central server and gaming terminals in order to facilitate the transfer and processing of gaming data. McCarthy specifically discloses the smart card contains information obtained from the central server, including gaming outcome data for use at a gaming terminal, and a processor (col. 8, lines 10-35; Fig. 3). Thus, the combinations of the teachings of Schneier and McCarthy would have been capable of producing a set of random numbers required to play the game in a smart card that is external to the gaming console. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Schneier and McCarthy as all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art.

Art Unit: 3717

14. In re claim 45, Schneier discloses the secure storage and processing device read/write interface of the gaming console communicates with the smartcard via the secure communications system (column 14 lines 12-17)

15. In re claim 58, Schneier discloses the secure storage and processing device communicates with a smartcard, thus in combination with the rejection of claim 37, the smartcard would be communicating with a further smartcard.

16. In re claim 60, McCarthy discloses a non volatile memory in the smartcard for recording player bet values and a total value owed to the player (figure 3 #42)

Response to Arguments

17. Applicant's arguments with respect to claim 9/23/10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS H. HENRY whose telephone number is (571)270-3905. The examiner can normally be reached on M-F 9 AM - 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on 571-272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3717

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melba Bumgarner/
Supervisory Patent Examiner, Art Unit 3717

THOMAS H HENRY
Examiner
Art Unit 3717